REMARKS

Claims 1, 4-10, and 12-16 are pending in this application. By the Office Action, claims 4 and 15 are allowed; claims 5-12 are withdrawn from consideration; and claims 1, 3, 13, 14, and 16 are rejected under 35 U.S.C. §102. By this Amendment, claims 1 and 14 are amended. Support for the amendments to claims 1 and 14 can be found in the specification at page 38, lines 10-13. No new matter is added.

I. Allowable Subject Matter

Applicant thanks the Examiner for the indication that claims 4 and 15 are allowed.

II. Rejections Under 35 U.S.C. §102(e)

Claims 1, 3, 13, 14, and 16 are rejected under 35 U.S.C. §102(e) as being anticipated by Sarkar et al. (U.S. Patent No. 6,465,081) ("Sarkar"). By this Amendment, claims 1 and 14 are amended to clarify that the filler is in the form of organic resin particles. Applicant respectfully traverses the rejection with respect to the amended claims.

As amended, independent claim 1 is directed to an image recording material comprising: a substrate having transparency; an image receiving layer provided on one side of the substrate and at which an image can be formed; an image being formable by an electrophotography system on the image receiving layer; and a transparent characteristic controlling member provided at a side of the substrate opposite to the side where the image is formed, wherein the characteristic controlling member comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a resin and filler, the filler in the form of organic resin particles, and the resin and the organic resin particle filler being present in a filler:resin ratio of from 0.3:1 to 3:1, and wherein the image can be seen when viewed through the substrate. Independent claim 14 is directed to an image recording material comprising: a substrate having transparency; an image receiving layer provided on one side of the substrate and at which an image can be formed; an image being

formable by an electrophotography system on the image receiving layer; and a characteristic controlling means provided at a side of the substrate opposite to the side where the image is formed, wherein the characteristic controlling means comprises a glossiness controlling layer that controls glossiness, and the glossiness controlling layer comprises a resin and filler, the filler in the form of organic resin particles, and the resin and the organic resin particle filler being present in a filler:resin ratio of from 0.3:1 to 3:1, and wherein the image can be seen when viewed through the substrate. Such image recording materials are nowhere disclosed in Sarkar.

Sarkar is cited as disclosing an image receptor sheet comprising a substrate having two opposite sides, an ink receptive layer on one side of the substrate, and an ink repellent layer on the other side of the substrate, wherein the ink repellent layer is toner powder receptive so as to allow the image receptor sheet to be used in electrophotographic printers (Office Action, page 2). According to the Office Action, the ink repellent layer of Sarkar is transparent and corresponds to the side of the substrate wherein the electrophotographic image is formed in the claims, and the ink receptive layer of Sarkar is transparent, comprises resin and filler, and corresponds to the characteristic controlling member in the claims. The Office Action further asserted that the Sarkar substrate is transparent.

The Examiner concluded that, "[s]ince the ink receptive layer is substantially identical to the claimed characteristic controlling member, the layer *inherently* functions as [a] glossiness controlling layer that reduces glossiness. Since all three layers are transparent, an image that may be provided on the ink repellent toner receptive layer can be seen when viewed through the substrate" (emphasis added) (Office Action, pages 2-3).

Regarding the claimed filler:resin ratio, the Office Action points to Examples 1 and 9 of Sarkar, and argues that the colloidal hydrated alumina used therein also are fillers, thereby

making the filler:resin ratio in those examples 0.53:1. The Office Action argues that those Examples fall within the claimed filler:resin ratio of from 0.3:1 to 3:1.

However, Sarkar does not disclose all of the limitations of the claimed invention.

A. Sarkar Does Not Teach a Filler:Resin Ratio of From 0.3:1 to 3:1

Sarkar does not disclose that the characteristic controlling member comprises a glossiness controlling layer comprising a resin and filler, the filler in the form of organic resin particles, and the resin and filler being present in a filler:resin ratio of from 0.3:1 to 3:1. At most, Sarkar teaches ratios far outside the claimed range.

The Office Action cites Examples 1 and 9 of Sarkar as anticipating the claimed invention. Example 1 of Sarkar teaches the use of 0.1% polymethylmethacrylate microspheres, 5.6% Hydroxypropylmethylcellulose, 3.0% colloidal hydrated alumina, 1.0% xylitol, 0.3% P134-Cl (polymeric mordant), and 90.0% water. Example 9 of Sarkar includes two different layers. The ink receptive layer includes the same composition as just described for Example 1. The ink repellent, toner powder receptive layer includes 0.05% polystearylmethacrylate microspheres, 4.15% isobornylacrylate/methylmethacrylate/ethylacrylate latex, 0.02% N-beta-(aminoethyl)-gamma-aminopropyltrimethoxysilane, 0.06% CYASTAT 609, and 95.71% water.

In the ink receptive layers of Examples 1 and 9, the resin is the 5.6% hydroxypropylmethylcellulose, and the organic filler is the 0.1% polymethylmethacrylate microspheres. The Office Action argues that the 3.0% colloidal hydrated alumina is also a filler material. Although Applicant disagrees, even if the Office Action is correct, the colloidal hydrated alumina is not a filler in the form of organic resin particles, and thus is not included in the instantly claimed filler:resin ratio. Accordingly, the filler:resin ratio of the ink receptive layers of Sarkar Examples 1 and 9 is 0.1% polymethylmethacrylate microspheres to

5.6% hydroxypropylmethylcellulose, i.e., 0.1:5.6, or 0.018:1. That ratio is far outside the claimed filler:resin ratio of from 0.3:1 to 3:1.

Likewise, in the ink repellent, toner powder receptive layer of Example 9, the resin is the 4.15% isobornylacrylate/methylmethacrylate/ethylacrylate latex, and the organic filler is the 0.05% polystearylmethacrylate microspheres. Accordingly, the filler:resin ratio of the ink repellent, toner powder receptive layer of Example 9 is 0.05:4.15, or 0.012:1. That ratio is also far outside the claimed filler:resin ratio of from 0.3:1 to 3:1.

Thus, Sarkar does not disclose a glossiness controlling layer that controls glossiness, where the glossiness controlling layer comprises a resin and a filler, the filler in the form of organic resin particles, and the resin and filler being present in a filler:resin ratio of from 0.3:1 to 3:1, as claimed. Sarkar teaches filler:resin ratios that are only 0.018:1 or 0.012:1, where are far below the lower claimed filler:resin ratio range limit of 0.3:1.

Accordingly, because Sarkar fails to disclose the claimed filler:resin ratio, Sarkar cannot anticipate the pending claims.

B. Sarkar Does Not Teach a Glossiness Controlling Layer

Sarkar also does not teach the glossiness controlling layer, as claimed. According to Sarkar, the ink receptive layer is coated on the side of the substrate that receives the image (col. 9, Example 9). The ink receptive coating comprises at least one layer of a hydrophilic polymer or blend of polymers and may include additives, such as fillers (col. 5, line 60, to col. 6, line 15). The filler "may be used to modify the mechanical properties of the [ink-receptive] coating" and may include colloidal silica and alumina (col. 6, lines 39-42).

The Office Action argues that the Sarkar ink receptive layer corresponds to the characteristic controlling member of the claims. However, in claims 1, 13, 14, and 16 the characteristic controlling member controls, including reduces, glossiness. For all of the reasons presented in Applicant's previous Amendment, there is no indication in Sarkar that

the ink receptive layer has or even could be made to have this capability. In order to anticipate a claim, the cited reference must disclose every limitation of the claim. Since Sarkar does not disclose glossiness control, Sarkar cannot anticipate the claims.

C. Conclusion

Accordingly, claims 1, 13, 14, and 16 are patentable over Sarkar. Reconsideration and withdrawal of the rejection are respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Joel S. Armstrong
Registration No. 36,430

JAO:JSA

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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